



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/881,820 | 06/15/2001 | Nancy W. Brandon | FIS9-2001-0180US1 | 7748 |

29505 7590 05/26/2004
DELIO & PETERSON, LLC
121 WHITNEY AVENUE
NEW HAVEN, CT 06510

EXAMINER

HIRL, JOSEPH P

ART UNIT PAPER NUMBER

2121

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--------------------------------------|---------------------------------------|--|
| Application No. 09/881,820 | Applicant(s) BRANDON ET AL. | |
| Examiner Joseph P. Hirl | Art Unit 2121 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 December 2003.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 June 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

Art Unit: 2121

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered March 8, 2004 for the patent application 09/881,820 filed on June 15, 2001.
2. The First Office Action of December 11, 2003 is fully incorporated into this Final Office Action by reference.

Status of Claims

3. Claims 10 and 20 are amended. Claims 21-24 are new. Claims 1-26 are pending.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Shetty et al (US Pub 2003/0084011, referred to as **Shetty**).

Art Unit: 2121

Claim 1

Shetty anticipates identifying a community of users belonging to the organization characterized by a common interest with respect to the knowledge (**Shetty**, Fig. 6A; Examiner's Note (EN): 604 is the portal interfacing with a community of users that belong to a dot.com organization); identifying business processes executed by the users in said community in accordance with strategies of the organization (**Shetty**, Fig. 6A); analyzing the business processes to identify specific activities performed in executing said processes and patterns for performing the respective activities (**Shetty**, Fig. 6A; p 0001); and constructing the knowledge portal in accordance with said patterns (**Shetty**, Fig. 6A, # 604).

Claim 2

Shetty anticipates analyzing the business processes to identify specific activities performed in executing said processes is by developing scenarios for using the portal in performing the respective activities and examining said scenarios to identify said patterns for performing the respective activities (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044).

Claims 3, 14

Shetty anticipates the usage scenarios are examined for recurring patterns of requests (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044).

Claims 4, 15

Shetty anticipates wherein the usage scenarios are examined for recurring patterns of requests selected from the group consisting of type of document, client,

Art Unit: 2121

industry, technology, collaboration group, application and any other recurring pattern observed in the usage scenario (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044).

Claim 5

Shetty anticipates each scenario associated with a given activity includes a description of the activity; a form of a request likely to be made by users to obtain knowledge relevant to the activity; a description of a result expected by the user in response to the request; and a list of known sources of knowledge that may be used in responding to the request (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044; p 0046).

Claims 6, 16

Shetty anticipates the list of known sources of knowledge that may be used in responding to the request is selected from the group consisting of documents, databases, web sites, or tools accessible via local area network (LAN), the organization's intranet, the external Internet, or other electronic means (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044).

Claim 7

Shetty anticipates common interest is selected from the group consisting of a common base of knowledge, tools and processes (**Shetty**, Fig. 6A); a common way of conceptualizing or organizing that knowledge (**Shetty**, Fig. 6A); and a set of peers with whom the community of users typically network or collaborate (**Shetty**, Fig. 6A).

Claim 8

Shetty anticipates including initially identifying business and knowledge strategies of the organization, and continually comparing the identified specific

Art Unit: 2121

activities and patterns for compatibility with the initially identified business and knowledge strategies of the organization (**Shetty**, Fig. 6A; ps 0041, 0042, 0043, and 0044; p 0046).

Claims 9, 19

Shetty anticipates constructing the knowledge portal includes organizing data into a hierarchy of categories and subcategories (**Shetty**, Fig. 6A; EN: to one of ordinary skill in the art, such organization is to be found in a given data base).

Claims 10, 20

Shetty anticipates wherein the hierarchy of categories and subcategories include type of document, support offering, client, industry, technology or any other categorization taxonomy that the community identifies as intuitive and natural to use in organizing the knowledge (**Shetty**, Fig. 6A; EN: see claim 9 comments).

Claim 11

Shetty anticipates reviewing strategies of the organization (**Shetty**, abstract); identifying a community of users characterized by a common interest with respect to the knowledge (**Shetty**, Fig. 6A; Examiner's Note (EN): 604 is the portal interfacing with a community of users that belong to a dot.com organization); identifying business processes executed by the users in said community in accordance with said strategies (**Shetty**, Fig. 6A); analyzing the business processes to identify specific activities performed in executing said processes (**Shetty**, Fig. 6A; p 0001); developing scenarios for using the portal in performing the respective activities (**Shetty**, Fig. 6A; p 0005); examining said scenarios to identify patterns therein (**Shetty**, Fig. 6A; p 0005); and

Art Unit: 2121

constructing the knowledge portal in accordance with said patterns (**Shetty**, Fig. 6A, # 604).

Claim 12

Shetty anticipates a description of the activity (**Shetty**, Fig. 6A); a form of a request likely to be made by users to obtain knowledge relevant to the activity (**Shetty**, Fig. 6A, # 604; EN: form can be represented by arrival of item purchased); a description of a result expected by the user in response to the request (**Shetty**, Fig. 6A; p 0005); and a list of known sources of knowledge that may be used in responding to the request (**Shetty**, Fig. 6A; p 0005).

Claim 13

Shetty anticipates a common base of knowledge, tools and processes (**Shetty**, Fig. 6A); a common way of conceptualizing or organizing that knowledge (**Shetty**, Fig. 6A; Figs. 1-4; or a set of peers with whom the community of users typically network or collaborate (**Shetty**, Fig. 6A).

Claim 17

Shetty anticipates initially identifying business and knowledge strategies of the organization (**Shetty**, Fig. 6A; ps 0041, 0042, 0043).

Claim 18

Shetty anticipates continually comparing the identified specific activities and patterns for compatibility with the strategies of the organization (**Shetty**, Fig. 6A; p 0007).

Art Unit: 2121

Claims 21, 22, 23, 24

Shetty anticipates the knowledge portal provides information search and retrieval by indexing content from multiple knowledge sources and delivering the content to users in the community (**Shetty**, Fig. 6A; p 0009; EN: multiple knowledge sources are supplier locations; indexing is done by noting such source; delivering the content to the users in the community is the pickup route).

Claim 25, 26

Shetty anticipates the hierarchy of categories and subcategories is determined from recurring knowledge retrieval patterns in usage scenarios of the community of users (**Shetty**, p 0004; EN: hierarchy is synonymous with classification or order; arrangements are patterns).

Response to Arguments

6. Rejection of claims 10 and 20 under 35 USC 112, second paragraph is withdrawn.
7. Applicant's arguments filed on March 8, 2004 related to Claims 1-25 have been fully considered but are not persuasive.

In reference to Applicant's argument:

The Examiner cites Fig. 6A and item 604 as disclosing all of the steps of claim 1. However, notwithstanding the Examiner's noted ability to construe the claims broadly, this portion of Shetty cannot reasonably be so broadly construed. For example, Fig. 6A identifies customers placing online orders from an Internet company 602, and the use of processing modules 608 to access a database 610 of customers and suppliers to create a pickup route 612 from suppliers and a delivery route 614 to the customers.

Art Unit: 2121

Examiner's response:

Para 9 below applies. As explained in the First Office Action, Page 3, lines 16-17, as related to claim 1, 604 is the portal interfacing with a community of users that belong to a dot.com organization. The claims and only the claims form the metes and bounds of the invention. The Examiner only recognizes claim based arguments.

In reference to Applicant's argument:

Applicants' invention delivers "knowledge" to the users of an organization by constructing a knowledge portal in accordance with the steps prescribed in claims 1 and 11. The Examiner identifies customers 604 which he deems to be comparable to applicants' claimed users belonging to an organization. However, the method described by Shetty does not deliver "knowledge" to those users, 'i.e., customers, but instead deliver tangible products by conventional shipping methods. Shetty is therefore non-analogous art since it is not directed to retrieving, organizing and delivering knowledge to a user. Moreover, applicants' invention is particularly directed to the method of organizing or categorizing business knowledge, data and tools prior to delivery of the knowledge to the user.

Examiner's response:

Para 9 below applies. In order for Shetty to deliver the tangible products, it is necessary to deliver "knowledge" as shown in Fig. 6A. ... note the network, database and computer.

In reference to Applicant's argument:

In particular, Shetty's method does not "identify a community of users belonging to the organization characterized by a common interest with respect to the knowledge" since the customers are ordering products, and have no common interest with respect to knowledge. Further Shetty does not identify business processes executed by the customers in accordance with strategies of the organization, or analyze the business processes to identify specific activities performed in executing such processes, as required by claims 1 and 11. Also, Shetty does not identify patterns for performing the specific activities performed in executing such processes, as required by claim 1, or develop scenarios for using the portal in performing the respective activities and examine the scenarios to identify patterns therein, as required by claim 11. Finally, Shetty does not construct the knowledge portal in accordance with such patterns. Accordingly, Shetty cannot be said to anticipate the specific steps and limitations of claims 1 and 11 with respect to constructing applicants' knowledge portal. Likewise, the specific steps and limitations of claims dependent on independent claims 1 and 11 are not disclosed or suggested in the Shetty publication, and Shetty cannot be said to anticipate those claims as well.

Examiner's response:

Para 9 below applies. Shetty's community of users have a common interest...they all want to receive their tangible product and in order to receive such product, Shetty's community are all linked by a common interest with respect to knowledge. To one of ordinary skill in the art, this is the only way Shetty's TSP will successfully implement. A delivery system is a business process. The TSP is a strategy system. The TSP has all the features of "business processes executed by the customers in accordance with strategies of the organization, or analyze the business processes to identify specific activities performed in executing such processes." To one of ordinary skill in the process, the TSP is a pattern process. The claims and only the claims form the metes and bounds of the invention. All of the noted features as related to claims have been identified in the First Office action and are still applicable.

In reference to Applicant's argument:

Applicants are also enclosing herewith a declaration under 37 CFR § 1.131 to swear behind the Shetty reference date of April 26, 2001. This declaration confirms applicants' invention of their claimed method steps prior to the date of the Shetty patent publication.

Examiner's response:

Without justifying circumstances and in recognition that Michael A. Limanni is a co-inventor (Applicant's Declaration under Rule 131, page 1, para 1), all inventors must be sign the Affidavit under Rule 131 (MPEP 715.04). General allegations related to completion of the invention prior to the date of reference is not sufficient (MPEP 715.07). Merely citing a date without producing factual evidence is insufficient to satisfy

Art Unit: 2121

37 CFR 1.131. The attachment to the Applicant's Declaration under Rule 131 is general in nature, fails to provide any dates and lacks features disclosed in the figures of the Disclosure. There is no date that establishes the date of the invention nor is there any evidence to demonstrate appropriate due diligence. The Affidavit is consequently rejected.

Examination Considerations

8. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

9. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and

Art Unit: 2121

unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

10. Examiner's Opinion

Para 10 above applies. The Affidavit is rejected because the applicant has not provided factual evidence that the invention was indeed conceived before April 26, 2001 and that appropriate due diligence was performed thereafter.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Claims 1-26 are rejected.

Correspondence Information

15. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II

2121 Crystal Drive,


Art Unit: 2121

Arlington, Virginia.



Joseph P. Hirl

May 24, 2004


RAMESH PATEL
PRIMARY EXAMINER
5/25/04
For Anthony Knight-